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| APPLICATION NO.                      | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/660,591                           | 09/12/2003  | Sinichiro Nakano     | 008312-0305942      | 7879             |
| 909                                  | 7590        | 07/28/2005           | EXAMINER            |                  |
| PILLSBURY WINTHROP SHAW PITTMAN, LLP |             |                      | ANWAH, OLISA        |                  |
| P.O. BOX 10500                       |             |                      | ART UNIT            |                  |
| MCLEAN, VA 22102                     |             |                      | PAPER NUMBER        |                  |
|                                      |             |                      | 2645                |                  |

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/660,591

Applicant(s)

NAKANO, SINICHIRO

Examiner

Olisa Anwah

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1, 4-6, 8, 11 and 12 are rejected under 35 U.S.C. § 102(e) as being anticipated by Isaka, U.S. Patent No. 5,706,388 (hereinafter Isaka).

Regarding claim 1, Nakano discloses a broadcast receiving apparatus including a content reproducer for receiving to reproduce broadcast content and a talking unit using a telephone line (see Figure 1), the broadcast receiving apparatus comprising:

a recording unit configured to record the received broadcast content onto a recording medium on in response to a

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talk request when there is an incoming call during the reproduction of the broadcast content; and

a recording and reproducing unit configured to reproduce the broadcast content recorded on the recording medium in response to a reproduction request and to write the received broadcast content over an area of the recording medium in which the reproduced broadcast content is recorded (see column 3).

Regarding claim 4, see column 3.

Regarding claim 5, see column 3.

Regarding claim 6, see column 3.

Regarding claim 8, Isaka discloses a method of controlling a broadcast receiving apparatus including a content reproducer for receiving and reproducing broadcast content and a talking unit using a telephone line (see Figure 1), the broadcast receiving apparatus control method comprising:

reproducing the broadcast content received;

determining whether there is an incoming call during the reproduction of the broadcast content; when there is an incoming call, recording the received broadcast content onto a recording medium in response to a talk request; and

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reproducing the broadcast content recorded on the recording medium in response to a reproduction request, and writing the received broadcast content over an area of the recording medium in which the reproduced broadcast content is recorded (see column 3).

Regarding claim 11, see Figure 1.

Regarding claim 12, see column 3.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 7 is rejected under 35 U.S.C § 103(a) as being unpatentable over Isaka in view of Lynch et al, U.S. Patent No. 5,438,423 (hereinafter Lynch).

On the matter of claim 7, Isaka doesn't explicitly teach the claimed fast-forwarding limitation. However Lynch discloses this mechanism (observe column 3). And so, it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to modify Isaka with fast-forwarding module of Lynch. This modification would have improved the convenience of Isaka by allowing the user to manipulate the broadcast as proposed by Lynch.

5. Claims 3, 10 and 14 are rejected under 35 U.S.C § 103(a) as being unpatentable over Isaka in view of Takagi et al, U.S. Patent No. 5,999,691 (hereinafter Takagi).

Regarding claim 3, Isaka fails to teach the claimed writing configuration. Yet Takagi reveals this limitation (notice column 8). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Isaka with the overwriting configuration of Takagi. This modification would have improved the convenience of Isaka by providing for a recording unit that automatically records the signal currently being received as suggested by Isaka.

Claims 10 and 14 are denied for similar grounds as claim 3.

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6. Claims 2, 9 and 13 are rejected under 35 U.S.C § 103(a) as being unpatentable over Isaka in view of Camras, U.S. Patent No. 3,946,147 (hereinafter Camras).

With respect to claim 2, 9 and 13 Isaka does not mention the claimed warning. But Camras explicitly demonstrates this element (see Figure 15). Hence it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Isaka with the claimed warning indicator of Camras. This modification would have improved the convenience of Isaka by permitting tape movement to be stopped at desired intervals as recommended by Camras.

#### ***Citation of Pertinent Prior Art***

7. Engstrom, U.S. Patent Application Publication No. 2004/0171377 (hereinafter Engstrom) is considered pertinent to applicant's disclosure.

#### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be

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reached on 571-272-7547. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

O.A-  
Olisa Anwah  
Patent Examiner  
July 13, 2005

  
FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600